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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/283,645 04/01/99 KHETANI

V CELG-0119

EXAMINER

HM12/0725

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ART UNIT

PAPER NUMBER

1625

DATE MAILED:

07/25/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/283,654

Applicant(s)
Khetani et al.

Examiner
Celia Chang

Group Art Unit
1625



☒ Responsive to communication(s) filed on Jun 7, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-8 and 10-13 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-8 and 10-13 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

1. Amendment and response filed by applicants in Paper No. 4, dated jun 7, 2000 have been entered and considered carefully. Claims 9 and 14 have been canceled. Claims 1-8, 10-13 are pending.

2. The rejection of claims 1-8, 10-11 and 13 under 35 USC 103(a) over Jursic (Branko Jursic) in view of Berrang, Ohashi or Vandeplas is maintained for reason of record.

Applicants argued that the resolving reagent of Jursic are amides thus one having ordinary skill in the art would not be suggested of the amended claims which are limited to chiral acids.

This argument is not persuasive. The Berrang, Ohashi or Vandeplas references taught that the conventional chiral acid are employed in resolving amine compounds analogous to the claims. Therefore, one having ordinary skill in the art would be motivated to employing an alternative chiral reagent in separating the instant amines as disclosed by Jursic. The difference in chemical structure between the chiral reagent of Jursic and Berrang, Ohashi or Vandeplas would not have prevented the picking and choosing by artisan in the field since all of them are known to be conventionally operable with amines.

3. The rejection of claim 12 under 35 USC 103(a) over Jursic (Branko Jursic) in view of Berrang, Ohashi or Vandeplas further in view of Patrick is maintained for reason of record

The same rational as explained supra in section is also applicable here.

4. In view of the amendment of claim 1, a new ground of rejection is necessitated.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8, 10-11, 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jursic in view of Berrang, Ohashi or Vandeplas and Feng et al. CA 117.

Jursic et al. disclosed process of separating enantiomeric isomers of the claims by formation of the racemic compounds with a chiral resolving agent (see p 1712-1713) in an organic solvent (see p 1713). The difference between the claims and Jursic is that instead of the chiral resolving agents disclosed on p.1712, applicants used an alternative conventional chiral resolving agent. The well recognition of the claimed chiral resolving agents are found in Berrang et al., Ohashi et al. or Vanderplas et al. wherein enantiomeric amino compounds are resolved into stereo isomeric forms through formation of a stereo specific complex between the compounds and the chiral agent. One having ordinary skill in the art would be motivated to employ these conventional chiral resolving agents for separation of enantiomers knowing that such isomers have been separated with alternative chiral agents as disclosed by Jursic. Especially it is well recognized that chiral acid such as tartaric acid will form tartrate with amide amines similar to the claims and are separable by fractional crystallization (see Feng).

5. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jursic et al. In view of Berrang et al. CA 97; Ohashi et al. CA 104; or Vanderplas et al. CA 118 and Feng et al. CA 117 further in view of Patrick et al.

The finding of prima facie obviousness over Jursic in view of Berrang, Ohashi or Vanderplas and Feng as delineated supra is also applicable here and incorporated here by reference. the instant claim 12 differs from the Jursic process in that an additional step for making the compounds from a pyridinyl precursor was incorporated. This precursor addition is also an conventional step in preparation of the claimed compounds as disclosed by Patrick (see p.487). Therefore, one having ordinary skill in the art who is well aware of all the pertinent art in

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the field, would be motivated to start the preparation from an alternative readily available precursor material as taught by Patrick with reasonable expectation of success.

6. Claims 1-8, 10-13 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 5,936,091. Although the conflicting claims are not identical, they are not patentably distinct from each other because the new amended claim included the scope of the issued patent.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

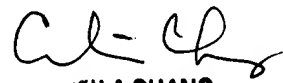
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Celia Chang whose telephone number is (703) 308-4702.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

CCC/Chang

July 20, 2000


CELIA CHANG
PRIMARY EXAMINER
GROUP 1200/1625